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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,125	11/21/2005	Jorg Heller	STERN21.003APC	8936

20995 7590 03/29/2007

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EXAMINER	
WONG, EDNA	
ART UNIT	PAPER NUMBER
1753	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	03/29/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/29/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
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Office Action Summary	Application No.	Applicant(s)	
	10/528,125	HELLER ET AL.	
	Examiner	Art Unit	
	Edna Wong	1753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 February 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

This is in response to the Amendment dated February 27, 2007. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Response to Arguments

Specification

The abstract of the disclosure has been objected to because the word "Said" is used in line 2.

The objection of the abstract of the disclosure has been withdrawn in view of Applicants' amendment.

Claim Objections

Claims **1 and 5** have been objected to because of minor informalities.

The objection of claims 1 and 5 has been withdrawn in view of Applicants' amendment.

Claim Rejections - 35 USC § 112

Claims **1-18** have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection of claims 1-18 under 35 U.S.C. 112, second paragraph, has been

withdrawn in view of Applicants' amendment.

Claim Rejections - 35 USC § 103

Claims **1-18** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **DE 198 55 666** ('666) and **Lehmkuhl et al.** (US Patent No. 6,652,730 B1) in combination with **Dotzer et al.** (US Patent No. 3,969,195).

The rejection of claims 1-18 under 35 U.S.C. 103(a) as being unpatentable over DE 198 55 666 ('666) and Lehmkuhl et al. in combination with Dotzer et al. is as applied in the Office Action dated November 27, 2006 and incorporated herein. The rejection has been maintained for the following reasons:

Applicants state that the combination of the cited references is not obvious, and is surprising, since it cannot be deduced from these documents that when the electrolytes according to Lehmkuhl are used, it is possible to expand the group of materials that can be treated in a single bath.

In response, Dotzer teaches that the coating and surface finishing of articles made of light metals, particularly beryllium, magnesium, aluminum, titanium and zinc and their alloys, is often necessary, because they are relatively base metals whose surfaces rapidly develop *a fundamentally oxidic coating* when exposed to the atmosphere. Such an oxidic coating usually protects the underlying metal against further corrosive attacks. However, the surfaces of articles made of such metals properly cannot be finished or coated in aqueous or *protic media*, due to the

characteristics of the metals and oxide coatings (col. 1, lines 15-25). An aprotic organo-aluminum electrolyte medium can be used to remove the oxidic coating (col. 6, lines 30-42) and electroplate aluminum onto the surface of the article (col. 7, lines 7-16).

Lehmkuhl teaches the electrolytic deposition of aluminum on electrically conductive materials using an aprotic organo-aluminum electrolyte medium (col. 1, lines 8-13).

Since beryllium and aluminum would have been obvious as the electrically conductive materials disclosed by Lehmkuhl, one having ordinary skill in the art would have been able to deduce when the electrolytes according to Lehmkuhl are used.

Applicants state that Lehmkuhl neither mentions anything about the pre-treatment procedure nor does it specify what kind of solution is used for the pre-treatment.

In response, the rejection is not overcome by pointing out that one reference does not contain a particular limitation when reliance for that teaching is on another reference. *In re Lyons* 150 USPQ 741 (CCPA 1966). Moreover, it is well settled that one cannot show nonobviousness by attacking the references individually where, as here, the rejection is based on a combination of references. *In re Keller* 208 USPQ 871 (CCPA 1981); *In re Young* 159 USPQ 725 (CCPA 1968).

Furthermore, claim 1, lines 3-4, recite "***immersing*** the material in an electrolytic bath comprising electrolyte for pretreatment, wherein said material is connected as an

anode therein". The pretreatment is the immersing of the material as an anode in an electrolytic bath comprising electrolyte. "Immersing" means to plunge or dip into a fluid. There is no electrolytic reaction during the immersing. Thus, the kind of solution that is used for the pretreatment would not have affected the method.

Applicants state that the electrolyte used for the pretreatment is different from the presently claimed invention because the '195 patent describes the use of halogen containing electrolytes for this purpose.

In response, the electrolyte used for the pretreatment would not have been different from the presently claimed invention when the polarity is reversed in the electrolytes disclosed by Lehmkuhl.

Furthermore, the claims as presently written are open to having halogens in the electrolyte bath.

Applicants state that the fused electrolyte described in the cited document is not suitable for the electrodeposition of aluminum, magnesium or aluminum/magnesium layers on other materials.

In response, claim 1, line 1, recites "electrolytic coating of *a material*". Lehmkuhl teaches the electrolytic deposition of aluminum on *electrically conductive materials* using an aprotic organo-aluminum electrolyte medium (col. 1, lines 8-13).

There is no reason why the electrically conductive materials disclosed by

Lehmkuhl are not suitable materials as presently claimed or suitable as other materials.

Applicants state that the methods described in the cited references are not suitable for the metal coating of magnesium, aluminum/magnesium alloys or zinc substrates.

In response, claim 1, line 1, recites "electrolytic coating of *a material*". There is no claim basis for magnesium, aluminum/magnesium alloys or zinc substrates. It is well settled that unpatented claims are given the broadest, most reasonable interpretation and that limitations are not read into the claims without a proper claim basis therefor. *In re Prater* 415 F. 2d 1393, 162 USPQ 541 (CCPA 1969); *In re Zeltz* 893 F. 2d 319, 13 USPQ 1320.

Response to Amendment

Claim Objections

Claims **1, 4-5 and 9** are objected to because of the following informalities:

Claim 1

line 3, the word -- an -- should be inserted after the word "comprising".

Claim 4

line 2, "%,-" should be amended to -- %- --.

Claim 5

line 2, the word -- bath -- should be inserted after the word "electrolyte" because the 3.3 mol toluene claimed is the aprotic solvent being used as the solvent for the electrolyte. Toluene is not the electrolyte.

Claim 9

line 3, the word -- bath -- should be inserted after the word "electrolyte" because the 3.3 mol toluene claimed is the aprotic solvent being used as the solvent for the electrolyte. Toluene is not the electrolyte.

Appropriate correction is required.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (571) 272-1349. The examiner can normally be reached on Mon-Fri 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Edna Wong
Primary Examiner
Art Unit 1753

EW
March 25, 2007